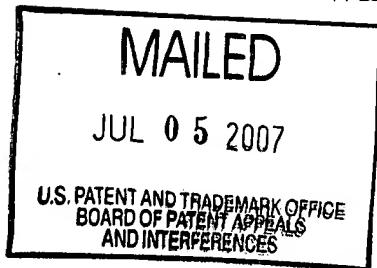


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD C.D. CHANG,
WILLIAM W. MAYFIELD, JOHN I. NOVAK, III
and
FRANK A. TAORMINA



Application 09/497,865

ORDER RETURNING TO THE EXAMINER

A review of the Image File Wrapper (IFW) indicates that a decision was rendered by the Board of Patent Appeals and Interferences (BPAI) on April 10, 2006, which affirmed the rejection of claims 1-5 and 7-37 under 35 U.S.C. § 103(a). A new ground of rejection was entered pursuant to 37 CFR § 41.50(b) as to claims 7-12 under 35 U.S.C. § 112, second paragraph.

37 CFR § 41.50(b) (2005) provides that the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Appellants timely filed an Amendment on May 30, 2006. The examiner refused entry of the Amendment and stated in the Office communication mailed July 17, 2006, that

since the amendment filed May 30, 2006 is not appropriate, it will not be entered. Accordingly, the rejection is not overcome. The application file is being returned to the Board so that a decision making the original affirmance final can be entered [page 3].

It should be noted that § 1214.01 of the Manual of Patent Examining Procedure (MPEP) (Rev. 3, August 2005) states:

If the examiner does not consider that the amendment and/or new evidence overcomes the rejection, he or she will again reject the claims. If appropriate, the rejection will be made final.

An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR 41.50(b)(1), after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to make the new ground of rejection made by the BPAI in the Board decision mailed April 10, 2006 final; and
- 2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: *Patrick J. Nolan*
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PJN:psb

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